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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,732	09/18/2003	Shanker Lal Gupta	224397	5615

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LEYDIG VOIT & MAYER, LTD
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EXAMINER

HENRY, MICHAEL C

ART UNIT PAPER NUMBER

1623

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,732

Applicant(s)

LAL GUPTA, SHANKER

Examiner

Michael C. Henry

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8-12,14-21,24-28,30-38,41-47 and 49-114 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8-12,14-21,24-28,30-38,41-47 and 49-114 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claims 1-5, 8-12,14-21,24-28,30-38,41-47 and 49-114 are pending in application

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5, 8-12,14-21,24-28,30-34, 55-66, 72-84, 86-102, 109-114 are rejected under the judicially created doctrine of double patenting over claims 1-32 of U. S. Patent No. 6,699,835 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 1, applicant claims "a compound of the formula (I) wherein R⁵ in each instance, is aryl, aralkyl, alkaryl,". Dependent claims, 2-5,8-12,14-21, 24-28 and 30-34 are further limitations of the compound of formula (I).

In claim 1, Plamondon et al. claims "a compound having the formula (I) wherein R⁵ in each instance, is one of aryl, aralkyl, alkaryl,".

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The difference between applicant's claimed compound and the compound of Plamondon et al. is that applicant compound of formula (I) is not limited to species in which R^5 in each instance is only one particular moiety such as aryl, aralkyl or alkaryl but encompasses species wherein R^5 in each instance, is not only one particular moiety.

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to have prepared a compound of formula (I) that is not limited to species in which R^5 in each instance is only one particular moiety such as aryl, aralkyl or alkaryl, since Plamondon et al. disclose that R^5 can be of the said claimed moieties.

One having ordinary skill in the art would have been motivated, to prepare a compound of formula (I) that is not limited to species in which R^5 in each instance is only one particular moiety such as aryl, aralkyl or alkaryl, since Plamondon et al. disclose that R^5 can be of the said claimed moieties.

Claims 35-54, 67-71, 85, 103-108 are rejected under the judicially created doctrine of double patenting over claims 33-50 of U. S. Patent No. 6,699,835 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 35, applicant claims "a method of preparing a lyophilized compound of formula (1)" Dependent claims, 36-54 are further limitations of the compound of formula (I).

Claim 33 of Plamondon et al. is drawn to "a method for formulating a boronic acid compound which is lyophilized.

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The difference between applicant's claimed method and the method of Plamondon et al. is that applicant claims specific boronic compounds of formula (I) and compounds that have hydroxyl groups and are derived from sugar.

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to claim specific boronic compounds of formula (I) and compounds that have hydroxyl groups and are derived from sugar to prepare the said lyophilized compound, since Plamondon et al. disclose that said compounds of the genus can be used to prepare the lyophilized.

One having ordinary skill in the art would have been motivated, to claim specific boronic compounds of formula (I) and compounds that have hydroxyl groups and are derived from sugar to prepare the said lyophilized compound, since Plamondon et al. disclose that said compounds of the genus can be used to prepare the lyophilized compound.

Claims 1-5, 8-12,14-21,24-28,30-34, 55-66, 72-84, 86-102, 109-114 are rejected under the judicially created doctrine of double patenting over claims 1-22, 38-49,54-66,,68-84 and 89-92 of U. S. Patent No. 6,713,446 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 1, applicant claims "a compound of the formula (I) wherein Z^1 and Z^2 together form a moiety derived from a sugar" Dependent claims, 2-5,8-12,14-21, 24-28 and 30-34 are further limitations of the compound of formula (I).

In claim 1, Gupta claims "a compound having the formula (I) wherein the sugar is mannitol."

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The difference between applicant's claimed compound and the compound of Gupta is that applicant compound of formula (I) claims sugar but not a particular sugar like mannitol.

It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to have prepared a compound of formula (I) that is not limited to any particular sugar, since Gupta claims that sugar can be the said moiety.

One having ordinary skill in the art would have been motivated, to prepare a compound of formula (I) that is not limited to any particular sugar, since Gupta claims that sugar can be the said moiety.

Claims 35-54, 67-71, 85, 103-108 are rejected under the judicially created doctrine of double patenting over claims 23-37, 50-53, 67, 85-88 of U. S. Patent No. 6,713,446 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: In claim 35, applicant claims "a method of preparing a lyophilized compound of formula (I)" Dependent claims, 36-54 are further limitations of the compound of formula (I).

Claim 23 of Gupta is drawn to "a method for formulating a boronic acid compound which is lyophilized.

The difference between applicant's claimed method and the method of Gupta is that applicant claims a sugar as a component in the preparation of said formulation whereas Gupta claims the specific sugar, mannitol.

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It would have been obvious to one having ordinary skill in the art, at the time the claimed invention was made to claim a sugar to prepare the said lyophilized compound, since Gupta disclose that said compounds of the genus can be used to prepare the lyophilized formulation.

One having ordinary skill in the art would have been motivated, to claim a sugar to prepare the said lyophilized compound, since Gupta disclose that said compounds of the genus can be used to prepare the lyophilized formulation.

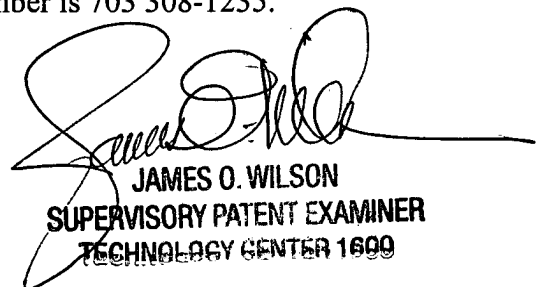
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Henry whose telephone number is 571-272-0652. The examiner can normally be reached on 8:30 am to 5:00 pm; Mon-Fri. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1235.

MCH

November 22, 2004.


JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600